



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

[Handwritten signature]

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,556	01/31/2001	Mitchell Anthony DeLong	79999	4976

23409 7590 07/18/2005
MICHAEL BEST & FRIEDRICH, LLP
100 E WISCONSIN AVENUE
MILWAUKEE, WI 53202

EXAMINER
MITCHELL, GREGORY W

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/774,556	DELONG ET AL.
	Examiner Gregory W. Mitchell	Art Unit 1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 April 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 11, 12, 16 and 21-50 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12, 16, 21-25, 35, 36, 40, 47 and 50 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 26-34, 37-39, 41-46, 48 and 49 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06/08/05</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

This Office Action is in response to the Remarks filed April 18, 2005. Claims 11, 12, 16 and 21-50 are pending. Claims 11, 12, 16, 21-25, 35, 36, 40, 47 and 50 are withdrawn from consideration. Claims 26-34, 37-39, 41-46, 48 and 49 are examined herein.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

35 USC § 103 Rejection Maintained

Claims 26-34, 37-39, 41-46, 48 and 49 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Johnstone (WO 98/33497) in view of DeLong et al. (WO 99/50241) for the reasons set forth in the Office Action dated December 14, 2004.

Applicant argues, "First, Johnstone does not teach or suggest a derivative of prostaglandin containing an oximyl- or an hydroxylamino group at the C11 position of the alicyclic ring, as claimed in the present application." This argument is not persuasive because one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Johnstone teaches the use of prostaglandins, derivatives or analogues thereof for the promotion of hair growth (Title; Abstract). Furthermore, Johnstone teaches that prostaglandins A₂, F_{2α} and E₂ types are preferred for the treatment method (Abstract). It would have been obvious to the skilled artisan to

Art Unit: 1617

look to the art to determine specific prostaglandins of the preferred type to be used in the invention of Johnstone. DeLong et al. teaches as known in the prior art a specific prostaglandin of the $F_{2\alpha}$ type which falls within the scope of the instant invention. Accordingly, it would have been obvious to one of ordinary skill in the art to utilize the prostaglandin of the $F_{2\alpha}$ type disclosed by DeLong et al. in a treatment of Johnstone because of an expectation of similar success to the general teaching of Johnstone.

Applicant further argues, "Second, while Johnstone mentions methods of enhancing hair growth, Johnstone does not stand for the proposition that all prostaglandins or even those useful in treating glaucoma, are useful for enhancing hair growth." This argument is not persuasive. As set forth above, Johnstone specifically teaches prostaglandin of the $F_{2\alpha}$ type as preferred prostaglandins for use in the invention disclosed therein. Johnstone further exemplifies a prostaglandin of the $F_{2\alpha}$ type. Accordingly, it would have been obvious to one of ordinary skill in the art to look to the art for prostaglandin of the $F_{2\alpha}$ type, particularly those known in the art to behave similarly to the one exemplified by Johnstone. DeLong et al. teaches 11-hydroxylamino-17-phenyl-17-trinor-PGF $_{2\alpha}$ as a known prostaglandin of the $F_{2\alpha}$ type that, like the exemplified prostaglandin of the $F_{2\alpha}$ type of Johnstone (latanoprost), is known in the art to be useful for similar biological purposes (e.g. in the treatment of glaucoma). Accordingly, it is Examiner's position that it would have been obvious to one of ordinary skill in the art to utilize the 11-hydroxylamino-17-phenyl-17-trinor-PGF $_{2\alpha}$, of De Long et al., as the specific prostaglandin of the $F_{2\alpha}$ type in Johnstone with an expectation of similar success in enhancing hair growth and treating hair loss therewith.

Applicant's arguments that because "Johnstone speculates that some of his proposed derivatives, 'may be irritating or otherwise not optimal, and in certain cases not even useful due to adverse effects ...'", "one skilled in the art would not be motivated to combine DeLong with Johnstone" is not persuasive. It is Examiner's position that it would have been obvious to combine DeLong with Johnstone for the reasons set forth both above and in the Office Action dated December 14, 2004. Furthermore, Applicant's argument is not persuasive because it suggests that one of ordinary skill in the art would not have been motivated to look to *any* derivative other than those specifically disclosed in Johnstone. Finally, the argument is not persuasive because whether or not a given derivative is "optimal" for the treatment disclosed by Johnstone is not required to render the claimed invention obvious. It would be obvious to one of ordinary skill in the art to look to the art to determine prostaglandin of the F_{2α} useful in a treatment of hair loss, as taught by Johnstone, because of an expectation of *similar* success to those specific examples exemplified in Johnstone, not an expectation of *optimal* success.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER